

**REMARKS**

This Amendment is responsive to the Office Action mailed March 10, 2005, in connection with the above-identified patent application. It addresses each of the objections and rejections posed the examiner. Accordingly, reconsideration is respectfully requested.

Applicant has made amendments to the specification that should address the inconsistencies noted by the examiner and render the specification allowable.

Claims 1-22 were originally presented. Claim 20 has been cancelled. Claims 11-13 have been withdrawn without prejudice. Claims 1-2, 9-10, 14, 16-18, and 21 have been amended. Claims 23-28 have been added.

Examiner has objected to claims 16, 18, and 20-21 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant has made amendments to the form of claims 16, 18, and 21 which should render them allowable in view of 37 CFR 1.75(c). Applicant has cancelled claim 20, as the method of combining the printing machine with a flexible plastic substrate with a surface finish adapted to accept ink is claimed in claim 7. Any rejections or objections to claim 20 should now be rendered moot.

Applicant has made amendments to claims 9, 14, and 17 that should address each of the noted informalities and render claims 9 and 14-22 readable and allowable in view of the examiner's objections.

In response to examiner's objection to claims 2-3, applicant has rewritten claim 2 in independent form including all of the limitations of the original base claim. As the examiner noted, the prior art of record fails to teach or fairly suggest a method including all of the steps as recited, in combination with and particularly including the step of retaining the substrate on the item in a jig by stretching elastic cords attached to the substrate so as to seat the substrate in a well structure on the jig.

Independent claim 2 as amended should now be in condition for allowance. Dependent claim 3 should also be allowable as dependent from an allowable base claim.

Examiner has rejected claims 1, 4, 9-10, and 14-22 under 35 U.S.C. § 102(b) as being anticipated by Dennesen. Applicant has amended claims 1, 10, 14, 16, and 18 to address the examiner's rejection.

By way of background, applicant claims a unique method for providing a customized decoration to an item by printing the decoration on a flexible plastic substrate adhered to and projecting from a surrounding surface of the item or by printing the decoration on a flexible plastic substrate attached to the item by elastic cords. Furthermore, applicant's unique method includes engaging the substrate in a jig fixedly attached to a support structure holding the item. By mounting the item in a support structure and isolating a flexible plastic substrate in a jig rather than printing the decorative formation directly to the surface of the item or mounting the entire item in the jig, applicant's method overcomes disadvantages in the prior art. Applicant's method enables cost-effective, practical, and on-demand custom decoration of items which may be too large and unwieldy (e.g. a bag or case, as opposed to small self-contained items such as golf balls, pencils

and the like) or may lack accurate registration points (e.g. a padfolio with soft fabric edges) for applying such custom decoration without either utilizing printing machines of impractical size and expense or maintaining a ready inventory of separate items and undecorated substrates for post-decoration assembly.

Dennesen teaches a method for providing a customized decoration to an item comprising providing an inking plate with a formation of a predetermined decoration, inking the plate with a brush, scraping excess ink from the plate using a scraping mechanism, masking the plate with an apertured shield, supporting the item in an article holder, and transferring, by a printing pad, ink from the formation directly to the surface of the item.

It is well-settled that for a claim to be anticipated under Section 102, an applied prior art reference must teach *each and every element* of that claim. Dennesen does not teach *a jig fixedly mounted with respect to the support structure for retaining a flexible plastic substrate adhered to the item, the flexible plastic substrate projecting from a surrounding surface of the item in combination with retaining the substrate on the item within the jig, including engaging at least a portion of the perimeter edge of the substrate to secure the substrate with respect to the jig during the printing step*. Dennesen also does not teach *a jig fixedly mounted with respect to the support structure for retaining a flexible plastic substrate attached to the item by elastic cords in combination with retaining the substrate on the item within the jig by stretching elastic cords attached to the substrate so as to seat the substrate in a well structure on the jig*. Accordingly, claims 1, 10, and 14 as amended are not anticipated by the prior art and should be allowable over Den-

nesen. Note, in particular, claim 10 as amended now includes the patentably distinct recitations found in claims 1 and 14.

Dependent claims 4, 9, and 15-22 and new dependent claims 23-28 should also be allowable over the prior art as dependent from allowable base claims. In particular, applicant's unique method, recited in claim 4, wherein the step of retaining includes *placing an edge of the item having the substrate mounted therealong against a wall of the jig and applying a plate containing an aperture in the shape of the substrate over the item so as to capture a perimeter edge of the substrate within the aperture*, provides additional modularity and functionality not contemplated by any prior art, and applicant's method enables practical on-demand printing of customized business accessories which would otherwise require impractically large printing machines or separate ready inventories of blank substrates and items. Dependent claims 5-6, 17-19, 23-25, and 28 recite either a method similar to claim 4 applied to other independent claims or further unique limitations dependent on such a method.

New dependent claims 23-25 and 28 are drawn to the unique retention and registration methods described in the specification at pages 6-7 and 10-11 and depicted in Figures 4, 13, and 14. In particular, claims 23, 25, and 28 are drawn to the unique hinged aperture design described in the specification at pages 10-11 and depicted in Figures 13 and 14.

New dependent claims 26-27 are drawn to optimizations of the printing machine described in the specification at page 9 and depicted in Figures 6-11. All new claims fur-

ther define patentably distinct features of allowable base claims as amended (discussed above) and should therefore be allowable.

Examiner has rejected claims 5 and 7-8 under 35 U.S.C. § 103(a) as being unpatentable over Dennesen, reasoning that Dennesen teaches a method as recited with the exception of the item being a portfolio or padfolio or the plastic substrate being covered with a surface finish to promote ink acceptance. As discussed above, Dennesen does not teach the method recited in claim 1 as amended, upon which claims 5 and 7-8 depend, nor is there any suggestion in Dennesen to retain a flexible plastic substrate, adhered to the item, projecting from the surrounding surface of the item, or attached to the item by elastic cords, in a jig fixedly mounted with respect to a support structure retaining the item, nor, absent impermissible hindsight, would applicant's method be obvious to those skilled in the art. Dennesen deals entirely with printing customized decorations directly on the surface of small self-contained items such as golf balls and pencils, and Dennesen does not address or suggest an efficient method for printing customized decorations on large items with separate substrates which must be accurately registered in the printing machine during the printing step; hence the limitations of the prior art, which demanded either impractically large printing machines or separate inventories of items and blank substrates for assembly *after* printing. Therefore, claims 5 and 7-8 should be allowable over the prior art as dependent from an allowable base claim.

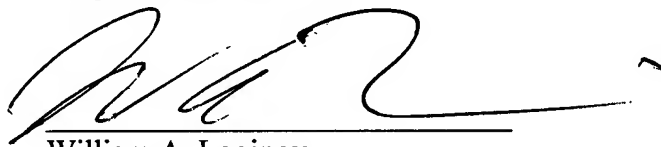
With reference to paragraph 9 of the Office action, applicant confirms that all claims were commonly owned at the time any inventions covered therein were made.

The application should now be in condition for allowance with the examiner's rejections being addressed or traversed. Applicant therefore respectfully requests the examiner to issue a Notice of Allowance at the earliest possible date.

Applicant earnestly solicits the examiner to contact the undersigned to advance the prosecution in any respect.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. Loginov', written over a horizontal line.

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